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PATENT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Alan J. Polito et al.

Confirmation No. 6774

Serial No.: 10/634,331

Group Art Unit: 1645

Filing Date: August 4, 2003

Examiner: HINES, Jana A

Title: METHOD AND APPARATUS FOR PERFORMING A LATERAL FLOW ASSAY

RESPONSE TO REQUIREMENT FOR RESTRICTION

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Restriction Requirement dated November 17, 2004, for which a response is initially due by December 17, 2004. Accordingly, this response is timely filed.

The Examiner required election of one of the following groups of claims:

Group I. Claims 98-106, drawn to an apparatus comprising a housing having a receptacle and an auto start means;

Group II. Claims 107-111, directed to an apparatus comprising a housing, an auto start means and a test strip;

Group III. Claims 112-113, drawn to a method of detecting an analyte using a lateral flow assay;

Group IV. Claims 114-115, drawn to a method of analyzing results of a lateral flow assay on a test strip; and

Group V. Claim 116, directed to a method of conducting quality control.

Applicants hereby elect to prosecute the claims of Group I, claims 98-106, with traverse. Applicants expressly reserve their right under 35 USC §121 to file one

or more divisional applications directed to the nonelected subject matter during the pendency of this application.

Applicants believe the present restriction requirement is improper. In particular, the Examiner appears to have chosen the groups based on the independent claims present, each group representing a set of claims depending from a different independent claim. For example, all of the claims of Group I either directly or ultimately depend from independent claim 98; all of the claims of Group II depend from independent claim 107; all of the claims of Group III depend from independent claim 112; all of the claims of Group IV depend from independent claim 114; and the only claim in Group V is independent claim 116. However, this is not a proper basis for a restriction requirement. In fact, under U.S. practice, applicants are allowed to include three separate independent claims without paying extra fees, indicating the Patent Office does not believe just because claims are independent they necessarily define different inventions.

Applicants believe at the very least that the claims of Group II, claims 107-111, should be examined along with the claims of Group I. Independent claim 98 of Group I recites an apparatus comprising a housing and an autostart means. Dependent claim 101 of Group I recites the apparatus further comprises a test strip. Independent claim 107 of Group II recites an apparatus comprising a housing, an autostart means and a test strip. Although the claims of Group I and Group II vary in scope, applicants submit that a search and examination of both groups of claims together would not impose a serious burden on the Examiner.

MPEP 803 states:

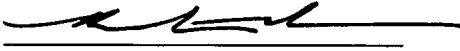
If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions. (Emphasis added).

Indeed, applicants believe that failure to examine the claims as suggested would pose a far greater burden on the Patent and Trademark Office by requiring a duplication of effort and resources. Accordingly, reconsideration of the present restriction and species election requirements is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 18-1648.

Respectfully submitted,

Date: 12/16/04

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